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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/630,753 | 08/02/2000 | David C. Taylor | 2852.2.1 | 8043 |

28049 7590 10/09/2003

PATE PIERCE & BAIRD
215 SOUTH STATE STREET, SUITE 550
PARKSIDE TOWER
SALT LAKE CITY, UT 84111

EXAMINER

NGUYEN, CUONG H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3625

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/630,753

Applicant(s)
Taylor et al.

Examiner
Cuong H. Nguyen

Art Unit
3625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/13/2002 (the Power of Attorney paper).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Status of the Claims

1. Claims 1-28 are pending in this application.

Priority

2. This application has a priority date of 8/03/1999 from a provisional application S.N. 60/146878 .

Election/Restriction

3. After reviewing the pending application, the election to one of the following inventions is deemed necessary. The delay of this requirement is regretted by the examiner of the record.
4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, and 13-20 are drawn to an computer apparatus to make a comparison, classified in US class 712, subclasses 1, 36, 228.
 - II. Claims 21-28 are drawn to a method for extracting information from the Internet, classified in class 345, subclasses 708 (i.e., a method to compare input context to a context in a database).
5. The inventions (group I and group II) are distinct, each from the other because of the following reasons:
6. Inventions Group I and Group II are related as apparatus and method for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP 806.05(e)). In this case, (2) confirms that

group I is directed to an apparatus (having its specific software and database) can be used to practice a different process (please note that an apparatus as claimed is merely a computer that is capable of performing many different processes) such as electronic shopping, trading/bidding in finance transactions, inventory management .etc.) not necessarily using that apparatus for context comparisons.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. A telephone call was made to Mr. A. John Pate (Reg.# 36,234) on 10/08/2003 to request an oral election to the above restriction requirement, but did not result in an election being made; therefore, a formal request for restriction is mailed.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Remark: Please note that in claim 21, a phrase of "locating the information that matches the macro-context in a database" lacks an antecedent basis for "macro-context in a database" because this macro-context is different from "input macro-context" mentioned in "acquiring a macro-context for the information based on the text".

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone

S.N. 09/630,753
Art Unit 3625

number is 703-305-4553. The examiner can normally be reached on Mon.-Fri.
from 7:15 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703)305-7687 [Official communications]

or 703-746-5572 (RightFax)

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA, 7th floor receptionist. Receptionist's telephone
number: (703)308-1113.

Chongfengfeng
Primary Examiner